

Docket 86697KNM
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
David G. Foster, et al

Group Art Unit: 1774

Examiner: Bruce4 H. Hess

SLIPPING LAYER FOR DYE-DONOR
ELEMENT USED IN THERMAL DYE
TRANSFER

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Serial No. 10/614,379

Filed 07 July 2003

Carol A. Kukurudza
Carol A. Kukurudza

April 27, 2005
Date

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Transmitted herewith is an amendment in the above-identified application:

- ☒ No additional fee is required.
☐ The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)	OTHER THAN A SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		* HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL		MINUS	20	0	X 50	\$0
INDEP		MINUS	3	0	X 200	\$0
	FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM				+ 360	\$ 0
					TOTAL	\$0

* The "Highest Number Previously Paid For" (Total or Independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment or the number of claims originally filed.

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☒ Any additional filing fees required under 37 CFR 1.16.

☒ Any patent application processing fees under 37 CFR 1.17.

(For Extensions of Time and other Petitions to the Assistant Commissioner)

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.



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DONOR ELEMENT USED IN
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REQUEST FOR RECONSIDERATION

In response to the Office Action dated 05 April 2005, Applicants provide the following remarks for review and consideration.

Claims 1-25 and 30-58 are rejected under 35 USC §103(a) over Hatada et al. (US 6,103,042) in view of either Henzel et al. patent, US 4,866,026 or US 4,916,112. For at least the following reasons, Applicants traverse the rejection.

Hatada et al. discloses a backing layer composition comprising a silicone material and a polymeric material as set forth at col. 4, lines 47-61. It is proposed by the Patent Office that one skilled in the art would know to select a polyolefin from this listing, and specifically a maleic anhydride polyolefin, as disclosed in col. 5, lines 42-51, specifically at lines 50-51. No other materials are suggested for the backing layer, for example, other waxes as claimed by Applicants.

Both patents to Henzel et al. describe a thermal donor having a slipping layer comprising a natural wax (4,916,112) or a functionalized polysiloxane in combination with a hydrocarbon, ester or amide wax.

Combining Hatada et al. with one or more Henzel et al. patent would result in a slipping or backing layer including a silicone-containing material and a wax, wherein the wax could include a polyolefin as set forth in Hatada et al. However, no guidance is provided in any of the applied references regarding how to choose a particular wax from any of a large category or list provided in each of the references. Further, use of a combination of two or more waxes is not disclosed or suggested in any of the applied references.

Applicants claimed invention, as exemplified in independent claims 31, 51, and 55, requires a lubricating material including at least a first wax which is a polymer derived from a polyolefin and an ethylenically unsaturated carboxylic acid or ester or anhydride, and at least one other wax. Applicants have shown unexpected results achieved by combining the claimed materials, as shown in the examples. Example 1, pages 17-19, demonstrates that a combination of waxes as claimed by Applicants has little retransfer, while the comparative siloxane-containing compositions has significant retransfer issues (see Table 1). Further, as shown in Example 2, pages 19-23, IP3, corresponding to a polyolefin and an ethylenically unsaturated carboxylic acid or ester or anhydride, alone has a very high POP, as does at least IP1. However, the combination of IP3 or IP2 with any other wax (IP1, IP2, or IP3) shows a synergistic effect, dramatically lowering the POP value.

The specific selection of a lubricant comprising a polyolefin and an ethylenically unsaturated carboxylic acid or ester or anhydride, and at least one other wax, is not disclosed or suggested by any of the applied references, alone or in combination. One skilled in the art would have to pick and choose from a very large number of possible waxes without a teaching as to preferred waxes, or a teaching as to combining two or more waxes, to find a combination that would result in Applicants' unexpected results.

For at least the above reasons, reconsideration and withdrawal of the rejection are in order, and are respectfully solicited.

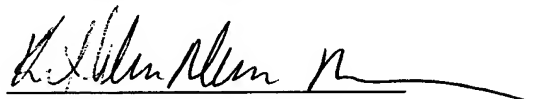
Claims 1, 13-25, 30 and 50 have been provisionally rejected under judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-19 of copending Application No. 10/614,600 in view of Hatada et al. While Applicants do not admit that the subject matter of the cited

application renders Applicants' claims obvious, in order to further prosecution and in accordance with 37 C.F.R. 1.321(c), Applicants enclose herewith a terminal disclaimer which is believed to overcome the double patenting rejection. Reconsideration and withdrawal of the rejection are thus respectfully requested.

For at least the reasons set forth above, Applicants submit all of Claims 1-25 and 30-58 are in condition for allowance. Prompt and favorable action is respectfully requested.

Should the Examiner require anything further, or have any questions, the Examiner is asked to contact Applicants' undersigned representative.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'K. Neuner Manne', followed by a long horizontal line extending to the right.

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